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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,968	06/22/2000	Manfred Berndt	4481-021	8551

7590

09/22/2003

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EXAMINER

BROWN, JENNINE M

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 09/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,968

Applicant(s)

BERNDT, MANFRED

Examiner

Jennine M. Brown

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-25 is/are rejected.
- 7) ☒ Claim(s) 15-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

Prosecution on the merits of this application is reopened on claims 1-25 considered unpatentable for the reasons indicated below:

1. Copending application 09/595420 has a common inventor and a common inventive entity with the instant application.

2. The priority dates are identical between the instant application and 09/595420.

3. The Action that was sent prior to the allowance was an Advisory Action (paper 11).

At that time double patenting and a 102(f) rejection were pending in the office action, therefore allowance was not proper. Although a literal translation of the priority document was made, Applicants did not provide evidence to the Examiner that their Applicant was the sole inventor of the subject matter claimed. The German document relied upon does not cite the Applicant himself as the inventor of the subject material, only the Assignee is named.

4. Only the subject matter previously given by the Examiner is novel over the copending application (09/595420) and has not been incorporated into the primary claim of the instant application.

5. As such, the primary claims of the instant application are fully encompassed by the specification and claims of the copending application 09/595420. Upon consulting with one of our Special Programs Examiners, it was noted that Applicants in the copending application have requested Interference proceedings to begin and proof of inventorship be shown for each claim.

6. Because of the pending 102(f) rejection and the provisional double patenting issues that remain between the two pending applications, the Examiner has withdrawn this case from issue.

Applicant is advised that the Notice of Allowance mailed is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-12 and 14 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The invention claimed in this application is fully encompassed by the specification and claims of a previously submitted application, 09/595420.

Non-statutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 and 19-25 of this application conflict with claims 1-13 of Application No. 09/595420. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims 1-14 and 19-25 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-13 of copending Application No. 09/595420. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

In the instant application there are five separate embodiments claimed.

1. The copending application, 09/595420, claims a system comprising a first physical unit, comprising a mounting region for receiving a microfluidic device, at least one second physical unit separated from the first physical unit comprising a material transport system which includes at least a first interface component wherein the first physical unit and second physical unit are oriented with respect to each other to provide potential to the microfluidic device through the first interface component which is removable from the second physical unit. Dependent claim 4 further limits the control unit to couple to the first interface component to control the potential to the microfluidic device. Dependent claim 5 comprises a control unit

Art Unit: 1755

coupled to the material transport system. Dependent claim 8 has the second interface component removably attached to the second physical unit. Dependent claim 8 has the second interface component mounted on the first interface component by a bayonet fitting. Dependent claim 12 comprises a microfluidic device received in the mounting region of the first physical unit. Dependent claim 13 comprises a microfluidic device wherein the material transport system is arranged within a module unit separably connectable with the second physical unit. More than one second physical unit is envisioned.

2. The system and device are equivalent in that they both have supply units to supply a microfluidic with an electrical potential. The interface element is equivalent to the interface component. Both interface element and component convert the power to the microfluidic in a releasable manner. Both use a holder to hold the interface element in an orientation to the microfluidic. The surfaces of the microfluidic stated in the specifications of each of the applications are the same and inherently would have the same chemical resistivity to solvent, cleaning agent or substances processed by the chip. Therefore, embodiments 1-6 would be encompassed by the copending claims of the copending application.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

Claims 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: copending application (09/595420) does not teach or suggest the use of a Hall Sensor/magnet pair, a shutoff responsive to the Hall Sensor/magnet pair or a warning device responsive to the Hall Sensor/magnet pair.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (703) 305-0435. The examiner can normally be reached on M-F 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 879-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jmb
September 17, 2003


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700